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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Stefanik.)

Special Program Examiner:

Serial No.: 09/751,468)

Kenneth A. Wieder

Filing Date: December 29, 2000)

Technology Center: 2600

Title: REMOTE CONTROL DEVICE WITH ILLUMINATION

REQUEST FOR RECONSIDERATION OF PETITION TO
WITHDRAW HOLDING OF
ABANDONMENT UNDER 37 C.F.R. 1.181(a)

Pittsburgh, Pennsylvania 15222

July 9, 2004

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JUL 16 2004

Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

Technology Center 2600

Sir:

A. Introductory Comments

This submission is responsive to the *Decision on Petition to Withdraw Holding of Abandonment* (the “*Decision*”) mailed May 10, 2004 in which Applicant’s *Petition to Withdraw Holding of Abandonment Under 37 C.F.R. 1.181(a)* (the “*Petition*”) was denied. A copy of the

“Express Mail” mailing label number ED152229295US

Date of Deposit July 9, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service “Express Mail Post Office to Addressee” service under 37 CFR 1.10 on the date indicated above and is addressed to the Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

Patricia A. Mack

Decision and of the *Petition* as filed are enclosed herewith. Applicant respectfully requests reconsideration of the *Petition* in view of the following remarks. Applicant submits that this submission does not require a fee. Nevertheless, the Commissioner is hereby authorized to charge any fees necessary for reconsideration of the *Petition* to Account No. 11-1110.

B. Remarks

In the *Decision*, the Office contends that “[t]he Supplemental Notice of Allowability does comply with 37 C.F.R. 1.85(c) in that the applicant was given a three month period of time from the mailing of the supplemental notice to correct the drawings or take other action in response to the examiner’s requirement to avoid abandonment.” Applicant respectfully submits, however, that the *Decision* fails to consider the absence of support for the Examiner’s requirement for corrected drawings in the first instance, as asserted in the *Petition*. Quite simply, the Office possessed (and acknowledged possession of) a complete set of formal drawings prior to issuance of the *Supplemental Notice of Allowability* (5).

In particular, as noted at page 3 of the *Petition*, 37 C.F.R. § 1.85(c) provides:

[i]f a corrected drawing is required or if a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of allowability within which the applicant must file a corrected or formal drawing in compliance with § 1.84 to avoid abandonment.

Thus, under § 1.85(c), the Office may properly require an applicant to provide a drawing if either of two threshold conditions is met: (1) a corrected drawing is required, or (2) a drawing does not comply with § 1.84 at the time the application is allowed. Applicant respectfully submits that an Examiner’s requirement for drawings in the absence of both conditions does not comply with § 1.85(c). As substantiated in the *Petition* and unquestioned by the Office in the *Decision*,

neither condition applied in this application at the time the *Supplemental Notice of Allowability* (5) was mailed. More specifically, the Office acknowledged receipt on January 18, 2002 of five sheets of formal drawings mailed by Applicant. *See* Postcard Receipt (1a). Additionally, in response to an Examiner's requirement for a proposed drawing correction or corrected drawing mailed April 11, 2003, Applicant filed *Response* (3) on June 10, 2003 that included a corrected drawing complying with 37 C.F.R. § 1.84. The Examiner's acceptance of the corrected drawing is evidenced in the *Notice of Allowability* (4) mailed August 25, 2003.

Thus, at the very least, the Examiner's unexplained reversal of position requiring corrected drawings in the *Supplemental Notice of Allowability* (5) was in error and unnecessarily duplicative, as the Office had already communicated the need for a corrected drawing, to which Applicant properly responded. More importantly, Applicant respectfully submits that the *Decision* elevates form over substance by premising denial of the *Petition* simply on the failure to respond to an erroneous request in the *Supplemental Notice of Allowability* (5), without due consideration of whether the Examiner requirement for corrected drawings contained therein was proper in the first instance under of § 1.85(c).

In summary, Applicant, prior to the mailing of the *Notice of Allowability* (4), had provided a complete set of formal drawings to the Office, including a corrected formal drawing. The Office acknowledged receipt of the formal drawings and their adequacy was acknowledged in the *Notice of Allowability* (4) by not requiring corrected drawings. Thus, prior to issuance of the *Supplemental Notice of Allowability* (5), the Office possessed a complete set of formal drawings that were deemed to have no deficiencies. Applicant submits that, due to an Office error or oversight on the *Supplemental Notice of Allowability* (5) (*i.e.*, the erroneous request for



corrected drawings), Applicant is being unfairly prejudiced and penalized by a holding of abandonment.

Respectfully submitted,

Daniel R. Miller

Daniel R. Miller
Reg. No. 52,030

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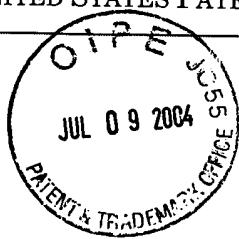
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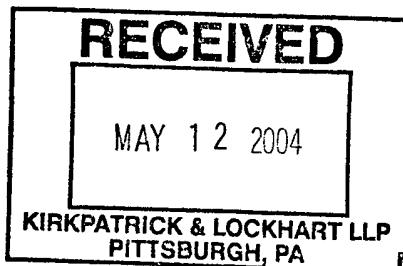


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John Stefanik, et al.
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COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFICE
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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

DECISION ON PETITION
TO WITHDRAW HOLDING OF
ABANDONMENT

Paper No. 27



This is in response to the petition filed March 16, 2004 to Withdraw Holding of Abandonment pursuant to 37 C.F.R. §1.181(a). No fee is required.

This application is in an abandoned status for failure to file corrected formal drawings as indicated by the Supplemental Notice of Allowability mailed October 20, 2003 which indicated that formal drawings are required including changes by the proposed drawing correction filed June 10, 2003. A Notice of Abandonment was mailed February 27, 2004.

Petitioner asserts that corrected formal drawings, complying with 37 CFR 1.84 were filed in response to an Office requirement. Petitioner further asserts that the corrected drawings were accepted by the Office as evidenced by the Notice of Allowability mailed August 25, 2003. Additionally it is urged that the requirement in the Supplemental Notice of Allowability for new formal drawing's is not supported by § 1.85(c) because the drawing filed June 30, 2003 was a "corrected drawing" complying with § 1.84 not merely a proposed drawing correction, and the Office accepted the corrected drawing at the time of allowance.

The Supplemental Notice of Allowability does comply with 37 CFR 1.85(c) in that applicant was given a three month period of time from the mailing of the supplemental notice to correct the drawings or take other action in response to the examiner's requirement to avoid abandonment. The file record is absent of any showing of response to the supplemental notice. Accordingly the Notice of Abandonment mailed February 27, 2004 is proper. The holding of abandonment has not been withdrawn.

The petition is **DENIED**.

Petitioner is given TWO MONTHS from the mailing date of the decision to request reconsideration. This time period is not extendable under 37 CFR 1.136(a). Petitioner may wish to consider filing a petition to revive an unintentionally abandoned application under 37 CFR 1.137(b).

Kenneth A. Wieder
Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
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